

Appl. No. : 10/021,388
Filed : December 6, 2001

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Information Disclosure Statement

Applicant notes that he has received from the Examiner the first initialed page of the Form PTO-1449 that was filed May 3, 2002, however the second page was missing. Applicant respectfully requests the Examiner to initial and return a copy of this page to Applicant.

Discussion of Rejections Under 35 U.S.C. § 112, 1st Paragraph and Changes to the Specification

In the Office Action, the Examiner objected to the abstract. Applicant respectfully submits that this has been corrected by the above-amendments.

Furthermore, in the Office Action, the Examiner stated that there is no support for “an input buffer register.” Applicant has corrected the claims to conform to the exact language used in the specification. Applicant respectfully submits that this is not a narrowing amendment because the definition of the terms “input buffer” encompasses and includes an input buffer register.

Furthermore, in the Office Action, with respect to Claim 11 the Examiner objected that the specification describes the use of a switch for performing both enabling a transfer and disabling a transfer and Claim 11 includes 2 means plus function limitations for “disabling a transfer gate” and “means for enabling a transfer.” Applicant respectfully submits that it is appropriate to use multiple means limitations to encompass the same structure in the specification. *See* Medtronic, 248 F.3d 1303, 1313 (Fed Cir. 1997). Furthermore, Applicant submits that dependent on the embodiment, “means for enabling” may cover different structure than the “means for disabling.” For example, different elements in the control logic 90 may be used to determine when to open a switch as opposed to when to close it.

Discussion of Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected Claims 1 and 4-9 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to Claim 1, in the Office Action, the Examiner had certain objections to lack of antecedent basis. In particular, the Examiner stated that the phrase “the chip select signal” has

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no antecedent basis. Applicant respectfully submits that support is found in line 4 of the claim. Furthermore, the Examiner objected to Claim 1 because it failed to recite a connection of a switch between the memory integrated circuit and a bus. Applicant respectfully submits that this issue has corrected this issue by the above-amendments.

With respect to Claim 4 and 7, the Examiner stated that “said logic circuit” lacks a proper antecedent basis. Applicant respectfully submits that these issues have been corrected by the above-amendments. With respect to Claim 8, the Examiner stated that “the bus”, “the chip select signal”, and said logic circuit” lack proper antecedent basis. Applicant respectfully submits that these issues have been corrected by the above-amendments. With respect to Claim 9, the Examiner stated that “fate” should be “gate.” Applicant respectfully submits that these issues have been corrected by the above-amendments.

Discussion of Claim Rejections Under 35 U.S.C. §§ 102(e) and 103(a)

In the Office Action, the Examiner rejected Claims 2-7 and 9-11 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,764,590 to Iwamoto (hereinafter “Iwamoto”). The Examiner rejected Claims 1 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Iwamoto in view of U.S. Patent No. 5,537,584 to Miyai, et al (hereinafter “Miyai”).

One embodiment of Applicant’s invention includes a switch that is used to control the parasitic capacitance of a bus. Claim 1, as amended, recites: “wherein the switch is operated so as to control the parasitic capacitance of the input/output terminals.” Independent Claims 2, 4, 7-9, and 11, as amended, recite similar limitations.

Applicant respectfully submits that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See* M.P.E.P. § 2131. Furthermore, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See* M.P.E.P. § 2143.03. Applicant respectfully submits that the cited references fails to teach or suggest at least one limitation from independent Claims 1, 2, 4, 7-9 and 11.

Iwamoto describes a selector (905). The selector (905) routes signals from a input buffer to one of two write registers. *See* Iwamoto, col. 50, col. 12. line 3. Applicant respectfully submits that there is no teaching or suggestion in Iwamoto that the selector (905) is used to control the parasitic capacitance of a bus. The selector (905) merely acts as a router of

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information. It does not control parasitic capacitance, such as by example, electrically isolating portions of a bus.

Furthermore, Applicant respectfully submits that these features are not taught or suggested by Miyai. Miyai was cited by the Examiner in support of the proposition that chip select signals were well known in the art. Applicant respectfully submits that Miyai fails to teach or suggest the use of a chip select signal so as to control the parasitic capacitance of a bus.

Since Iwamoto and Miyai fails to teach or suggest at least the above limitation in isolation or in combination, Applicant respectfully submits that independent Claims 2, 4, 7-9, and 11 are in condition for allowance. Furthermore, since Claims 3, 5, and 10 each depend on one of Claims 2, 4, and 9, Applicant respectfully submits that these claims are allowable fore the reasons previously discussed.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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